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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,910	07/31/2003	Hiroyuki Yanagisawa	KON-1807	9630
20311	7590	04/25/2006	EXAMINER	
LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			CHEA, THORL	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/631,910

**Applicant(s)**

**YANAGISAWA, HIROYUKI**

**Examiner**

## Thorl Chea

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is responsive to the communication submitted on January 18, 2006; claims 1-12, 14-20 are pending in this instant application; claim 13 has been canceled.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-3 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 4-12. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). There is no difference in composition of the material invention claimed in claims 1-3 and that claimed in claims 4-12 contains same composition. Claims 1-3 and claims 4-6 have same composition except different notation of color coordinates, i.e. (u\*, v\*) vs (a\*, b\*). Likewise, claims 7-9 and claims 10-12 have same composition, optical density and value of  $R^2$ .

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. There is no antecedent basis for the "minimum density" in claim 1, line 8 and claim 4, line 8. Moreover, the claiming of minimum density is indefinite since this value is relative to the process.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-12, 14-20 are rejected under 35 U.S.C. 103(a) as obvious over either EP 1278101 (EP'101), Nishijima et al (US Patent No. 6,699,649) or Patent Specification 1543266 (PS'266) in view of Yoshioka et al (US Patent No. 6,413,712). EP'102, Nishijima et al and PS'266 discloses a photothermographic material containing a reducing agent having formula with the scope of A-1 claimed, except the compound of formula A-4. See EP'101, Nishijima et al and PS'266 on page 15, formula (I) wherein R3 represent an aryl group (a phenyl group or naphthyl group). Yoshioka et al disclose a compound of formula A-4 claimed in the present claimed which when used in combination with a bisphenols compound provide a photothermographic material affording a sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing. See column 2, lines 12-18 and formula (II). It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the phenol compound taught in Yoshioka et al in the material of either EP'101, Nishijima et al or PS'266 with an expectation of achieving a photothermographic material affording a sufficient

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image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing, and thereby provide a material as claimed. The regression value as claimed is considered as inherent to the combination of reducing agent stem obtained by the combination of those taught in the applied prior art of record after the image forming process since the combination of the bisphenols reducing agent and the phenol compound taught in Yoshioka et al provide a sufficient density and suppressing the time depend tint of the white back ground after processing, and the regression value present in the claimed invention is related to the control of color tone of the material after processing.

8. Claims 1-12, 14-20 are rejected under 35 U.S.C. 103(a) as obvious over the combination of Oya et al (US Patent No. 6,376,166) and Yoshioka et al (US Patent No. 6,413,712). Oya discloses photothermographic material having a reducing agent within the scope of the claimed invention. See compound of formula (I) in the abstract and the definition of  $V^9$  in column 7, lines 55-60 which an aryl group such as phenyl, p-methylphenyl and naphthyl, except the compound of formula (A-4). Yoshioka et al disclose a compound of formula A-4 claimed in the present claimed which when used in combination with a bisphenols compound provide a photothermographic material affording a sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing. See column 2, lines 12-18 and formula (II). It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the phenol compound taught in Yoshioka et al in the material of Oya et al with an expectation of achieving a photothermographic material affording a sufficient image density under general

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image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing, and thereby provide a material as claimed. The regression value as claimed is considered as inherent to the combination of reducing agent stem obtained by the combination of those taught in the applied prior art of record after the image forming process since the combination of the bisphenols reducing agent and the phenol compound taught in Yoshioka et al provide a sufficient density and suppressing the time depend tint of the white back ground after processing, and the regression value present in the claimed invention is related to the control of color tone of the material after processing.

9. Claims 1-12, 14-20 are rejected under 35 U.S.C. 103(a) as being obvious over the combination of Morita et al (US Patent 6,958,209) and Yoshioka et al (US Patent No. 6,413,712).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the

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reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2). See Morita et al in columns 105-108 which discloses a photothermographic material containing the compound A-1 and A-3 claimed in the present claimed invention, except the compound A-4 which has been known in Yoshioka et al as development accelerator which provide a photothermographic material with sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing. See column 2, lines 12-18 and formula (II). It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use a known development accelerator in the material taught in Morita et al with an expectation of achieving a photothermographic material with sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-12, 14-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. U.S. Patent No.

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6,699,649 in view of Yoshioka et al (US Patent No. 6,413,712). The invention claimed in the U.S. Patent No. 6,699,649 differs from the claimed invention in the use of the compound of formula (A-4). Yoshioka et al disclose a compound of formula A-4 claimed in the present claimed which when used in combination with a bisphenols compound provide a photothermographic material affording a sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing. See column 2, lines 12-18 and formula (II). It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the phenol compound taught in Yoshioka et al in the material claimed in the copending application with an expectation of achieving a photothermographic material affording a sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing, and thereby provide a material as claimed. The regression value as claimed is considered as inherent to the combination of reducing agent stem obtained by the combination of those taught in the applied prior art of record after the image forming process since the combination of the bisphenols reducing agent and the phenol compound taught in Yoshioka et al provide a sufficient density and suppressing the time depend tint of the white back ground after processing, and the regression value present in the claimed invention is related to the control of color tone of the material after processing.

12. Claims 1-12, 14-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of Morita et al (U.S. Patent No. 6,958,209) in view of Yoshioka et al (US Patent No. 6,413,712). The invention claimed in Morita et al and that claimed in the present claimed invention are substantially similar, except the compound of

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formula A-4 which has been known in Yoshioka et al as development accelerator which provide a photothermographic material with sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing. See column 2, lines 12-18 and formula (II). It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use a known development accelerator in the material claimed in Morita et al with an expectation of achieving a photothermographic material with sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing.

***Response to Arguments***

13. Applicant's arguments filed January 18, 2006 have been fully considered but they are not persuasive of the reason set forth above. The compound of formula A-1, A-3 and A-4 has been known in the art as reducing agent and as development accelerator such as disclosed in the applied prior art above. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to those compound as reducing agent for silver ions for the photothermographic composition with an expectation of achieving a material with a desired silver tone image. The Declaration submitted under 37 CFR 1.132 on January 18, 2006 has been considered, but found insufficient to overcome the prima facie case of obviousness set forth above. The invention as claimed is related to the regression coefficient using different coordinate system and different points such as  $(u^*, v^*)$ ,  $(a^*, b^*)$ , optical density of 0.5, 1.0, 1.5, the minimum density point, and 0.5, 1.0, 1.5 to provide coefficient of determination  $R^2$  from 0.998 to 1.000. The Declaration fails to clearly point out as to why the use of different color

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coordinate system and graph of different set of point provide similar results. Moreover, the results shown in the Declaration is related to the use of silver salt of an aliphatic carboxylic acid such silver behenate which is the more preferred silver salt of an organic acid shown in the applicants' disclosure and the applied prior art of record. It appears silver salt of an organic acid other than silver salt of an aliphatic carboxylic acid would provide similar results when combined with the bisphenols reducing agent. Therefore, it would appears that the probative value of the evidence is not commensurate with the degree of protection sought. In re Kulling, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990); In re Grasselli, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983); In re Landgraf, 436 F.2d 1046, 168 USPQ 595 (CCPA 1971).

The rejection under the judicially created doctrine of obviousness-type double patenting set forth above are maintained since the applicants fails to provide an argument that the filing of Terminal Disclaimer is not necessary to obviate such rejection.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *th*  
April 11, 2006

*Thorl Chea*  
Thorl Chea  
Primary Examiner  
Art Unit 1752